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EXAMINER
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NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/515,297

Applicant(s)

RICHTER, CLARK ADAM

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 28-56 are currently pending and have been examined.

***Response to Arguments***

Applicant's arguments filed 21 January 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Since the Examiner has not included knowledge gleaned only from the applicant's disclosure and has relied on the teachings and suggestions of the prior art and used knowledge within the level of ordinary skill at the time the invention was made as taught by the prior art, the Examiner has not based the obviousness conclusion based on improper hindsight reasoning.

The Applicant argues that Werb does not say that the technologies of RFID and bar coding are interchangeable and uses

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this argument to show that the Examiner has made a hindsight-based obviousness analysis. It has been held that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, there is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness." See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). For example, motivation to combine prior art references may exist in the nature of the problem to be solved (*Ruiz* at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (*National Steel Car v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)). The Applicant concedes that the statement wherein the technologies of RFID and bar coding are interchangeable might be sufficient to show teaching or modification to combine references. In this case, Werb's statement regarding the replacement of bar coding technology with RFID technology is given as the motivation to combine the teachings and suggestions of Kadaba and Werb.

In response to the Applicant's argument that the combination of Kadaba and Werb does not disclose the present

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invention, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this case, as shown in the previous Office Action, the Examiner has shown how the combination of Kadaba and Werb in view of the teachings and suggestions made within Kadaba and Werb. The Applicant also argues that the combination of Kadaba and Werb does not teach receiving first information stored in a memory of said RFID tag, said first information including an address identifying a location on a computer network corresponding to said RFID tag and communicating with said location identified by said address and an RFID tag having a memory containing at least an address identifying a location on a computer network. The Examiner has shown how this limitation

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is met by the combination of Kadaba and Werb in view of the teachings and suggestions disclosed in Kadaba and Werb. The Applicant also argues that Werb does not teach a memory including a data field containing an address identifying a location on a computer network corresponding to said RFID tag. Again, the Examiner has shown how this limitation is met by Werb in view of the teachings of Werb.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 28-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 539 360 B1 to Kadaba in view of US Patent 6 150 921 A to Werb et al.

Regarding claim 28, Kadaba discloses a method for reading a tag (the "tag" referred to throughout the reference as "bar code" or "label"; column 2, lines 43-59, specifically lines 47-50) located on a package, comprising:

receiving first information including first data regarding the package (column 6, lines 37-53, specifically lines 39-41);

communicating with a computer ("intranet web site") at a location identified by an address and accessing second information ("pre alert file") from said location on said computer network (column 7, lines 52-61; column 8, lines 54-60), said second information including second data regarding said package (column 7, lines 3-15 and 34-37); and

updating said second information at said location on the computer network to reflect said first data regarding said package. (column 8, lines 54-60)

Kadaba does not disclose receiving the first information that is stored in a memory of a RFID tag, said first information including an address identifying a location on a computer network corresponding to a RFID tag and first data regarding said package, however, Kadaba does disclose receiving first

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information including first data regarding the package as shown above. Kadaba also does not disclose interrogating a RFID tag located on said package, however, Kadaba does disclose reading a tag located on a package (column 2, lines 47-50).

Werb discloses a RFID tag containing a memory to be able to store information comprising data regarding a package (column 1, lines 41-54, specifically lines 44-48) and is also used to track packages (column 1, lines 11-15 and 49-54). Werb also discloses interrogating a RFID tag located on a package (column 1, lines 11-15, 35-40, and 49-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Kadaba with the RFID tag of Werb. Werb discloses that RFID tags are a known improvement to those skilled in the art to bar coding (column 1, lines 24-25). Therefore, one of ordinary skill in the art would have been motivated to combine the references based on the specific advantages of the RFID technology disclosed in Werb as opposed to the bar coding technology disclosed in Kadaba.

It also would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Kadaba with the RFID tag of Werb to include the address identifying a location a computer network in a RFID tag. Werb



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discloses a RFID tag containing a memory to be able to store information comprising data regarding a package and is also used to track packages as shown above. Werb also discloses that RFID tags are a known improvement to those skilled in the art to bar coding as shown above. Kadaba discloses communicating with a computer at a location identified by an address to update the second information at the location as shown above. Kadaba also teaches that the updating of the second information occurs when the tag is read by a device (column 8, lines 58-60). Therefore, these disclosures would have suggested to one of ordinary skill in the art to include the address with a RFID tag disclosed in Werb since Kadaba discloses that reading a tag automatically updates the second information at the location (column 8, lines 58-60) and one of ordinary skill would have recognized that the step occurs if the reader or interrogator had access to the address at the time of reading or interrogation. One of ordinary skill would have considered it to be routine skill to include the address in memory of the RFID tag to allow the reader or interrogator to have instant access to the address in view of the disclosures regarding electronic manifests in Werb.

Therefore, it would have been obvious to achieve the limitations as recited in the claim.

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Regarding claim 29, Kadaba and Werb disclose the method of Claim 28.

Kadaba discloses wherein said second information is updated automatically without requiring any further interaction by said operator. (column 8, lines 58-60)

Kadaba does not disclose wherein said RFID tag is interrogated by an RFID reader commanded by an operator of said RFID reader.

Claim 29 is rejected since the motivations regarding the obviousness of claim 28 also apply to claim 29.

Regarding claim 30, Kadaba and Werb disclose the method of Claim 28.

Kadaba discloses wherein said second data comprises a detailed description of said package. (column 7, lines 3-15 and 34-37)

Werb also discloses this limitation (column 1, lines 11-15 and 35-54, specifically "electronic manifest" and "item tracking")

Regarding claim 31, Kadaba and Werb disclose the method of Claim 30.

Kadaba discloses wherein said detailed description comprises a content of said package and a document associated with said content, said document comprises one of a document on

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a toxicity of said content, a document on a radioactivity level of said content, a document on a clean-up requirement of said content, and a document of disposal data of said content.

(column 7, lines 3-15 and 34-37)

Regarding claim 32, Kadaba and Werb disclose the method of Claim 28.

Kadaba discloses wherein said address further comprises a Uniform Resource Locator (column 8, lines 54-58) and wherein said location further comprises a website ("intranet web site").

Kadaba does not disclose wherein said second information is updated with said first data by executing a Java-applet associated with said website, however, Kadaba does disclose updating the second information with the first data at the website as shown above. Werb also does not disclose this limitation.

It would have been obvious to one skilled in the art at the time the invention was made to use a Java-applet to update the second information because the Applicant has not disclosed that using the limitation undisclosed in Kadaba or Werb provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method of updating the second

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information described in Kadaba as recited in the claim because the method of updating the second information in Kadaba uses a website to store the second information and it would have been a matter of design choice to use a web site operated means such as a Java-applet to receive the first data and update the second information.

Regarding claim 33, Kadaba and Werb discloses the method of Claim 32.

Kadaba discloses wherein said accessing step further comprises said website to obtain said updated second information. (column 7, lines 52-61; column 8, lines 54-60)

Regarding claim 34, Kadaba and Werb disclose the method of Claim 33.

Kadaba discloses wherein said updated second information comprises a current information regarding a delivery status of said package. (column 7, lines 3-15; column 8, lines 6-10)

Regarding claim 35, Kadaba and Werb disclose the method of Claim 34.

Kadaba discloses wherein said delivery status comprises one of a status on a location of said package and a status on an arrival time of said package. (column 7, lines 3-15; column 8, lines 6-10)

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Regarding claim 36, Kadaba and Werb disclose the method of Claim 35.

wherein said accessing step further comprises automatically launching a browser application and automatically loading said Uniform Resource Locator into an address field of said automatically launched browser application.

Regarding claim 37, Kadaba and Werb disclose the method of Claim 28.

Kadaba discloses wherein said address further comprises an e-mail address. (column 8, lines 54-60; column 9, lines 3-24, specifically lines 16-24)

Regarding claim 38, Kadaba and Werb disclose the method of Claim 37.

Kadaba discloses the method further comprising:

launching an e-mail client and communicating an e-mail message associated with said first data regarding said package to a customer of said package through said e-mail client, said customer having said e-mail address. (column 8, lines 54-60; column 9, lines 3-24, specifically lines 16-24)

Regarding claim 39, Kadaba and Werb disclose the method of Claim 38.

Kadaba discloses wherein said e-mail message comprises one of a message on a location of said package and a message on an

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arrival time of said package. (column 7, lines 3-15; column 8, lines 6-10; column 8, lines 54-60; column 9, lines 3-24, specifically lines 16-24)

Regarding claim 40, Kadaba and Werb disclose the method of Claim 28.

Kadaba does not disclose wherein said memory of said RFID tag has a limited storage capacity and wherein said second data regarding said package supplements said first data regarding said package.

Werb discloses a RFID tag with a limited memory capable of accepting information from an interrogator including information regarding electronic manifests. (column 1, lines 41-54, specifically lines 44-48)

Claim 40 is rejected since the motivations regarding the obviousness of claim 28 also apply to claim 40.

Regarding claim 41, Kadaba and Werb disclose the method of Claim 28.

Kadaba does not disclose wherein said second information from said location on said computer network is further updated with information regarding a location of where said RFID tag is interrogated, however, Kadaba does disclose wherein said second information from said location on said computer network is

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further updated with information regarding a location of where said tag is read. (column 7, lines 3-15; column 8, lines 6-10)

Claim 41 is rejected since the motivations regarding the obviousness of claim 28 also apply to claim 41.

Claim 42 is rejected since claim 42 contains the same limitations as recited in claim 29.

Claim 43 is rejected since claim 43 contains the same limitations as recited in claims 28 and 40 in combination.

Claims 44 and 45 are rejected since claims 44 and 45 contain the same limitations as recited in claims 41 and 29 respectively.

Regarding claim 46, Kadaba and Werb disclose the computer network system of Claim 45.

Kadaba discloses the system further comprising:

a local network; ("intranet")

a global network; ("internet") and

a host server ("central computer") connected with said client computer via said local network, said host server being further connected to said global network; (column 6, lines 37-39) and

wherein said client computer accesses said location by an operation of said application through said host server. (column 6, lines 26-30)

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Regarding claim 47, Kadaba and Werb disclose the computer network system of Claim 46.

Kadaba discloses the system further comprising a wireless access point directly connected to said local network and wherein said host server is connected with said client computer through said wireless access point. (column 5, lines 48-59)

Regarding claim 48, Kadaba and Werb disclose the computer system of Claim 47.

Kadaba discloses wherein said client computer is a handheld wireless device that is wirelessly connected to said wireless access point. (column 5, lines 48-59)

Regarding claim 49, Kadaba and Werb disclose the computer system of Claim 48.

Kadaba does not disclose wherein said RFID reader is located within said handheld wireless device, however, Kadaba does disclose that a tag reader is located within said handheld wireless device (column 5, lines 48-59).

Claim 49 is rejected since the motivations regarding the obviousness of claim 28 also apply to claim 49.

Claim 50 is rejected under 35 USC 103(a) since claim 50 contains the same limitations as recited in claims 28 and 41 in combination.



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Claim 51 is rejected under 35 USC 103(a) since claim 51 contains the same limitations as recited in claim 37 and 38 in combination.

Claims 52 and 53 are rejected under 35 USC 103(a) since claim 52 and 53 contains the same limitations as recited in claim 40.

Claim 54 is rejected under 35 USC 103(a) since claim 54 contains the same limitations as recited in claims 28 and 30 in combination.

Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werb et al.

Regarding claim 55, Werb discloses a radio frequency identification (RFID) tag comprising:

a memory having a data storage area; (column 1, lines 41-54, specifically lines 44-48)

an RF interface coupled to said memory for communicating data between said memory and an external interrogator (column 1, lines 15-23)

Werb does not disclose wherein said memory including a data field containing an address identifying a location on a computer network corresponding to said RFID tag.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an address in

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the memory of the RFID tag disclosed in Werb since Werb discloses that the memory may contain any sort of information such as electronic manifests used for a plurality of fields of endeavor including item tracking (column 1, lines 41-54). Therefore, one of ordinary skill in the art would find it obvious to modify Werb to place an address in the memory of the RFID tag.

Regarding claim 56, Werb discloses the RFID tag of Claim 55.

Werb does not disclose wherein the address further comprises a Uniform Resource Locator.

Claim 56 is rejected since the motivations regarding the obviousness of claim 55 also apply to claim 56.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches wherein bar coding technologies are replaced with RFID technologies:

US Patent 6 394 355 to Schlieffers et al, column 9, lines 43-46;

US Patent 6 557 758 to Monico, column 1, lines 20-37.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

  
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